

REMARKS

1. The Examiner has objected to Claim 10 under 31 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Examiner states that Claim 10 is dependent on claim 6 and the body of claim 10 is also identical to claim 6. Therefore, claim 10 fails to further limit the subject matter of claim 6.

Applicant has amended Claim 10 to now depend from Claim 7. Applicant respectfully submits that the objection to Claim 10 is overcome and that the objection under 31 CFR 1.75(c) should be withdrawn.

2. The Examiner has rejected to Claims 1, 4 - 6 and 10 under 35 U.S.C. 102(b) as being anticipated by August et al., (U.S. 5,671,267).

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* basis for rejection of Claims 1, 4 - 6 and 10 under 35 U.S.C. 102(b). To constitute a "description" of a patented invention within the meaning of 35 USC § 102(b) the prior publication must describe the invention as claimed in full, clear and exact term so as to allow a person skilled in the art to practice the invention. Vague and general representations are not sufficient to support a defense of anticipation under the law. *Ballantyne Instruments & Electronics, Inc., vs. Wagner*, 345 F.2d 671, 673-74, 145 USPQ 408 (1965). In a rejection based on 35 U.S.C. §102, a cited and applied reference must teach every aspect of the invention, either implicitly, or explicitly. MPEP 706.02. For these reasons, applicant respectfully submits that the Examiner has failed to establish a *prima facia* case for rejection under 35 U.S.C. §102(b).

August et al. fail to teach the Applicant's claimed invention in that the radio transmitter and receiver of August et al. is linked to a "base unit" which is hard wired to a telephone circuit (211). Because of this interaction between the handset (10) and base unit (20), there are significant differences in the signal path, including two antennas, (199) and (214), two transmitters (113) and (212), two receivers, (114) and (213), and two control units, (110) and (210). See August et al. Fig. 2. and Col. 6; lines 34 – 37. Furthermore, the radio receiver must transmit through a "speakerphone" (134) to the radio transmitter (113). See August et al. Fig. 2. The function of this device is unclear and there is no such connection in the Applicant's claimed invention. August et al. also teach a "data

interface circuit" (123), which is an input for a hard-wired tip-ring connection. (Col 5; lines 51-54). Thus, the data interface circuit (123) shows that the telephone handset circuit disclosed in August et al. is clearly not a "wireless communications device."

Similarly, August et al. fails to teach the "remote control circuit" of Applicant's claimed invention. August et al. show only that a command signal may be sent by infrared signals (Fig. 2. Col. 5, lines 55-60). However, the Applicant's specification defines "remote control circuit" to include either infrared or short wave radio **transmission or reception**. (Pg. 5, third paragraph).

Finally, August et al. does not teach that the control circuit comprises a switch for switching operations between the remote control and a telecommunications circuit, as is claimed in Claim 6. Rather, August et al. explicitly shows that such an operation is controlled by a hard-wired switch (320) (Fig 3; Col. 7, lines 24-29). Since August et al. disclose a complex radio signal pathway at odds with Applicant's invention, hard-wired devices including a base unit and data interface circuit, a limited remote control circuit, and hard wired switch instead of a switchable control unit, Applicant respectfully submits that August et al. fails as a primary reference, and requests that this basis for rejection be withdrawn and Claims 1, 4-6, and 10 be allowed.

3. The Examiner has rejected Claims 2 - 3 and 7 - 9 under 35 U.S.C. 103(a) as being unpatentable over August et al. (U.S. 5,671,267) as applied to the Claim 1 above, and further in view of Yamashita et al (U.S. 6,223,034). Inasmuch as August et al. fails as a primary reference, Applicant respectfully submits that the rejection of Claims 2 - 3 and 7 - 9 under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Yamashita et al (U.S. 6,223,034) is unsupportable.

Additionally, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art and must not be based on applicant's disclosure. MPEP, 7<sup>th</sup> ed. Revision 1, February 2000, § 706.02(j) citing *In re Vaek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP, 7<sup>th</sup> ed. Revision 1, February 2000, § 706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicant respectfully submits that the Examiner fails to state a proper *prima facie* case for obviousness in rejecting Claims 2 - 3 and 7 - 9 under 35 U.S.C. 103(a). Applicant notes that no reference is cited for this specific motivation. This unsupported conclusion is improper according to M.P.E.P § 2143.01 and competent case law. Since there is no reference given for this motivation, Applicant would request that this basis for rejection be withdrawn and the Claims allowed.

Applicant requests that this basis for rejection be withdrawn, and Claims 2-3 and 7-9 be allowed.

4. Applicant believes the application is in condition for allowance and respectfully requests the same. If the Examiner is of a differing opinion he/she is hereby requested to conduct a telephonic interview with the undersigned attorney.



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